

REMARKS

A. Claims 1, 15, 16, 19-22 and 58

On page 2 of the Office Action, the Examiner has rejected claims 1, 15, 16, 19-22 and 58 under 35 USC 102(e) as being anticipated by Sorin et al. U.S. Patent No. 6,510,261. Applicant respectfully traverses this rejection and submits that the above claims are in allowable form.

It is clear that in order for Sorin et al. (US 6,510,261) to be a valid prior art reference under 102(e), it would have to be entitled to the benefit of a filing date that is earlier than Applicant's date of invention. Of course, the Applicant's date of invention cannot be later than the filing date of the instant application, i.e., May 30, 2000. However, this should in no way be construed as an admission that the date of invention is indeed May 30, 2000. Should it be necessary to do so at a subsequent stage of prosecution, Applicant expressly reserves the right to establish a date of invention earlier than May 30, 2000.

Now, Sorin et al. (US 6,510,261) is at the end of a chain of CIP's. Specifically, Sorin et al. (US 6,510,261) is a CIP of US 6,510,261, filed Dec 4, 2000, which is a CIP of app. no. 09/666,763 filed Sept 21, 2000 and app. no. 09/571,092 filed May 15, 2000, now US 6,253,002, which is a CIP of app. no. 09/425,099 filed Oct 22, 1999, now US 6,233,379, which is a CIP of app. no. 09/022,413 filed Feb 12, 1998, now US 6,021,237.

In addition, Sorin et al. (US 6,510,261) claims the benefit of provisional application no. 60/206,767, filed May 23, 2000.

From the above, it is clear that in order for Sorin et al. (US 6,510,261) to be entitled to claim the benefit of an earlier filing date than May 30, 2000 (without acquiescing in this date as being Applicant's earliest date of invention), the subject matter cited in the Examiner's rejection would need to be supported by the disclosure of one of Sorin et

al.'s US patents filed prior to May 30, 2000 or in provisional application no. 60/206,767 filed May 23, 2000. Indeed, this appears to be the position implicitly taken by the Examiner in asserting the rejection under 102(e). Applicant respectfully refutes this position and submits that the subject matter cited in the rejection finds no support in US 6,253,002, US 6,233,379 or US 6,021,237. Moreover, in view of this information and in the absence of any evidence to the contrary, Applicant reasons that provisional application no. 60/206,767 filed May 23, 2003, in all likelihood, also does not support the Examiner's rejection.

Specifically, the Examiner's rejection asserts that claims 1, 15, 16, 19-22 and 58 are anticipated by disclosure of the following elements in Fig. 31 of Sorin et al. (US 6,510,261):

- channel equalizer with optical switch (172, 182)
- wavelength division multiplexers (162, 184)
- optical splitters, TAP (162, 184)
- variable optical attenuators, VOA (152)
- spectral monitor (174)

None of these elements or reference numerals is taught or suggested in US 6,253,002 or US 6,021,237 or US 6,233,379 (with the possible exception of the rather generic expression "optical switch", found in isolation in US 6,233,379). Furthermore, Fig. 31 of Sorin et al. (US 6,510,261), to which the Examiner makes specific reference, is not present in any of the above three patents.

Therefore, it should be apparent that each of claims 1, 15, 16, 19-22 and 58 comprises at least one limitation that is neither taught nor suggested in any of the patents issued from the Sorin et al. chain of CIPs that could conceivably be applied under 102(e) against the claims in question. Moreover, Applicant further suggests that the short eight-day difference in filing dates between US 6,253,002 [May 15, 2000] and provisional application 60/206,767 [May 23, 2000] renders it unlikely that the above

elements are present in provisional application 60/206,767, when they were absent from US 6,253,002. Applicant further maintains this position in the absence of any indication from the Examiner that Sorin et al. US 6,510,261 is indeed entitled to the benefit of provisional application 60/206,767 insofar as the disclosure of the above-cited elements of Fig. 31 is concerned.

In view of the foregoing, the Examiner is respectfully requested to withdraw his rejection of claims 1, 15, 16, 19-22 and 58. If the Examiner's 102(e) rejection is maintained on the sole ground that US provisional application 60/206,767 has an earlier filing date than Applicant's filing date, then the Examiner is respectfully requested to positively demonstrate Sorin et al.'s entitlement to the benefit of the earlier filing date insofar as the disclosure of the above-cited elements of Fig. 31 is concerned.

It should also be noted that Applicant's arguments presented herein above response have not addressed the merits of the Examiner's arguments, only the applicability of the cited reference (Sorin et al. US 6,510,261). However, this should in no way be construed as an admission by the Applicant that the Examiner's arguments or contentions have any merit whatsoever. Should the Examiner succeed in presenting evidence that overcomes the applicability issues that have been raised herein above, the Applicant expressly reserves the right to take the position that claims 1, 15, 16, 19-22 and 58 meritoriously distinguish over Sorin et al. US 6,510,261.

B. Claims 2, 3, 23, 24

On page 3 of the Office Action, the Examiner has rejected claims 2, 3, 23 and 24 under 35 USC 103(a) as being unpatentable over Sorin et al. U.S. Patent No. 6,510,261 in view of Taylor et al. U.S. Patent No. 6,049,413. Applicant respectfully traverses this rejection and submits that the above claims are in allowable form.

Claims 2 and 3 are dependent on claim 1 and therefore comprise all of the limitations of claim 1 already shown to be absent (in the case of US 6,253,002, US 6,021,237 and US

6,233,379) or likely absent (in the case of provisional application 60/206,767) from the documents to which Sorin et al. can rightfully claim a filing date earlier than May 30, 2000. In addition, these elements are not disclosed in Taylor et al. For this reason alone, it can be seen that the Examiner has failed to satisfy the full set of criteria required for establishing a *prima facie* case of obviousness in accordance with MPEP 706.02(j)¹. Hence, the Examiner is respectfully requested to withdraw his rejection of claims 2 and 3.

Claims 23 and 24 are dependent on claim 20 and therefore comprise all of the limitations of claim 20 already shown to be absent (in the case of US 6,253,002, US 6,021,237 and US 6,233,379) or likely absent (in the case of provisional application 60/206,767) from the documents to which Sorin et al. can rightfully claim a filing date earlier than May 30, 2000. In addition, these elements are not disclosed in Taylor et al. For this reason alone, it can be seen that the Examiner has failed to satisfy the full set of criteria required for establishing a *prima facie* case of obviousness in accordance with MPEP 706.02(j). Hence, the Examiner is respectfully requested to withdraw his rejection of claims 23 and 24.

It should also be noted that Applicant's arguments presented herein above response have not addressed the merits of the Examiner's arguments, only the applicability of the cited reference (Sorin et al. US 6,510,261). However, this should in no way be construed as an admission by the Applicant that the Examiner's arguments or contentions have any merit whatsoever. Should the Examiner succeed in presenting evidence that overcomes the applicability issues that have been raised herein above, the Applicant expressly reserves the right to take the position that claims 2, 3, 23 and 24 meritoriously distinguish over the combination of Sorin et al. US 6,510,261 and Taylor et al. U.S. Patent No. 6,049,413.

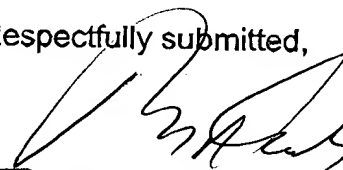
¹ For the Examiner to establish a *prima facie* case of obviousness, three criteria must be considered: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art references must teach or suggest all of the claim limitations. MPEP §§ 706.02(j), 2142 (8th ed.).

CONCLUSION

In view of the foregoing, the Applicant is of the view that claims 1-3, 15-16, 19-24 and 58 are in allowable form. Favourable reconsideration is requested. Early allowance of the Application is earnestly solicited.

If the application is not considered to be in full condition for allowance, for any reason, the Applicant respectfully requests the constructive assistance and suggestions of the Examiner in drafting one or more acceptable claims pursuant to MPEP 707.07(j) or in making constructive suggestions pursuant to MPEP 706.03 so that the application can be placed in allowable condition as soon as possible and without the need for further proceedings.

Respectfully submitted,



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